



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1470
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

09/632,959

08/04/2000

Sanjay M. Parekh

39518/203866

1066

23370

7590

09/13/2005

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
ATLANTA, GA 30309

EXAMINER

ZHONG, CHAD

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/632,959

Applicant(s)

PAREKH, SANJAY M.

Examiner

Chad Zhong

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 10-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed on 06/27/2005.
2. Claims 1-12 are presented for examination. In amendment B, filed on 06/27/2005, claims 10-12 are withdrawn from further consideration:
Claim 8 is amended.
Claims 1-7, and 9 are previously presented.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, drawn to method of obtaining a geographic location of an Internet user that accesses an external network from a private network through a proxy server, classified in class 709, subclass 203
 - II. Claims 10-12, drawn to method for resolving a domain name inquiry to assist in gathering geographic location of an Internet user, classified in class 709, subclass 227 and 245.
4. The inventions are distinct, each from the other because of the following reasons:
Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I has separate utility such as in a method of obtaining a geographic location of an Internet user that accesses an external network from a private network through a proxy server, but lacks domain name service inquiry, and resolving the inquiry by returning a first IP address if the inquiry did not originate from within the private network, the first IP address being associated with an external server located outside of the private network. In the instant case, Invention II has separate utility such as resolving a domain name inquiry to assist

Art Unit: 2152

in gathering geographic location of an Internet user, but lacks a method of redirecting by the external server the request for information to an internal server of the private network. See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

a. Group I search (claims 1-9) would require use of search of class 709, subclass 203 (which would not be required for Group II).

b. Group II search (claims 10-12) would require use of search of class 707, subclass 227 and 245 (which would not be required for Groups I).

6. A telephone call was made to Jason Jackson on August 9th 2005 to request an oral election to the above restriction requirement,

During a telephone conversation with Jason Jackson on August 9th 2005 a provisional election was made without traverse to prosecute the invention of group 1, claim 1-9

Applicant in responding to this Office Action must make affirmation of this election. Claim 10-12 are withdraw from further consideration by examiner, 37 CFR 1. 142(b), as being draw to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 (c) of this title before the invention thereof by the applicant for patent.

9. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al. (hereinafter Gupta), US 2001-0020242

10. As per claim 1, Gupta teaches the invention as claimed wherein a method for obtaining a geographic location of an Internet user that accesses an external network (external network being the external/foreign ISP [0060]) from a private network (private network being home ISP [0060]) through a proxy server ([0054], wherein ISP and proxy are analogous), comprising:

receiving by an external server on the external network a request for information from an Internet user through the proxy server (user roams to foreign ISP, to request foreign information [0060]).

determining by the external server that the request for information is through the proxy server ([0060], the external/foreign ISP determines the request is from a user out side of its own ISP, hence, the foreign ISP will query or forward request towards the home ISP for user profile data);

redirecting by the external server the request for information to an internal server of the private network ([0055], [0057], [0060], the 3rd party advertisers can request for user profile information from the private network proxy, this request is forwarded towards home ISP for user profile data); the internal server determining the geographic location of the Internet user ([0033], [0055], [0057]);

receiving by the external server (external/foreign ISP [0060]) the geographic location from the server

Art Unit: 2152

within the private network ([0060], [0066], wherein the user profiles are send to the requesting external/foreign ISP); and

using the geographic location of the Internet user in handling the request for information from the Internet user ([0066]).

11. As per claim 2, Gupta teaches wherein the external network is Internet ([0008]).
12. As per claim 3, the claim is rejected for the same reasons as rejection to claim 1 above.
13. As per claim 4, Gupta teaches receiving the request from a machine associated with the Internet user ([0066], machine is the user terminal, Fig. 4, item 400).
14. As per claim 5, 6, Gupta teach determining the geographic location based on an internal address associated with the Internet user and a geographic location/internal IP address mapping table contained within the private network [0030].
15. As per claim 7, Gupta teaches the method as set forth in claim 3, wherein sending the geographic location to the external network comprises:

sending the geographic location to an external server on the external network ([0066]; [0060]); and

redirecting a machine associated with the Internet user to the external server ([0060], wherein the foreign/external ISP may retrieve or purchase the profile of user, the client's computer will access the web server through route B,C,E).
16. As per claim 8, the claim is rejected for the same reasons as rejection to claim 1 above.
17. As per claim 9, Gupta teaches the external network is Internet ([0008]).

Response to Arguments

18. Applicant's remarks filed 06/27/2005 have been considered but are moot in view at the new grounds of rejection as necessitated by Applicant's arguments

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "Determining Geographic Locations of Private Network Internet Users".

- i. US 6571279 Herz et al.
- ii. US 5857191 Blackwell, Jr. et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (571)272-3946. The examiner can normally be reached on M-F 7:15 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BURGESS, GLENTON B can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Application/Control Number: 09/632,959

Page 7

Art Unit: 2152

CZ

July 25, 2005